

REMARKS

The Examiner, in the Official Action, has again finally rejected claims 1, 2, 4-9, 29-33 and 44-47 for the reasons set forth therein. In response to Applicant's previous response, the Examiner submits that the Applebaum et al reference discloses a separate image product substrate connected by means of folding. The Examiner states that Applebaum has simply been shown to illustrate an image product connected by a hinge as a means of folding. The Examiner states that the Roberson et al. reference has been cited to illustrate first and second substrates which are separated by a fold line between the substrate as indicated. The Examiner then goes forth to state that it would have been obvious to one of ordinary skill in the art to modify Applebaum's image product with a hinge having a fold line as taught by Robertson for the purpose of naming of the folding of the two substrates. Applicant respectfully submits that it would not be obvious to combine the references suggested by the Examiner. The CAFC in *In re Lee* 277 Fed 3<sup>rd</sup> 1338 (61 USPQ 2<sup>nd</sup> 1430) 2002 states that:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

The central question is whether there is reason to combine the references.

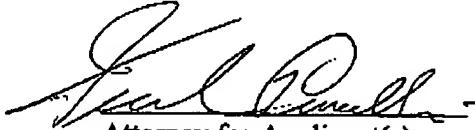
"the factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record ... a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding ... there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant."

Teaching of the reference can be combined only if there is some suggestion or incentive to do so. Applicant respectfully submits as previously noted, the Applebaum reference teaches away from providing the single unitary object. The Applebaum reference is specifically directed to avoiding the providing of a folding to which the Examiner has cited Robertson for making the folding. It is respectfully submitted that the fact that Applebaum is directed to avoiding the problem, teaches away from making the obvious combination suggested by the Examiner as this would destroy the purpose to which the Applebaum is directed.

The Examiner goes on to state that the Examiner is interpreting Figures 11-14 as depicting a support substrate 12 being non interrupted and continuous support substrate, wherein the non-interrupted continuous substrate is embossed forming a first continuous interrupted substrate portion and a second continuous non-interrupted substrate portion. Applicant does not clearly understand what the Examiner means in this section. As illustrated in Figure 14, the substrates 12 and 14 are permanently secured together. Figure 12 illustrates one method of producing a fold line within the substrates according to the present invention. The substrates are still continuous except that a fold line has been provided thereon. Each of the substrates 12, 14 are continuous. These substrates 12, 14 are permanently secured together wherein a fold line is folded in the composite structure. The embossing disk of Figure 12 is simply illustrating one method of how the fold line may be produced.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.